

Application No. 09/649,436
Amendment dated September 7, 2004
Reply to Office Action mailed March 5, 2004

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed March 5, 2004. Claims 1, 6, 10, 19, 22 and 34 are amended. Claims 1, 2, 6 and 10-46 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. PRIOR ART REJECTIONS

A. Rejections Under 35 U.S.C. §102

1. *Lumsden*

The Examiner rejects claims 1-2, 6 and 10-43 under 35 U.S.C. § 102(a) as being anticipated by *Lumsden* (United States Patent No. 6,006,217).¹ As will be shown, the methodology used by *Lumsden* is different from the invention that is currently claimed, and thus the reference does not anticipate any of the rejected claims under 35 U.S.C. § 102(a). In particular, because *Lumsden* does not teach or suggest each and every element of the rejected claims as amended, Applicants respectfully traverse this rejection in view of the following remarks.

In the Office Action, beginning at the top of page 13, the Examiner characterizes the teachings of *Lumsden* and concedes that a "search result" located using the search methodology

¹ In the Office Action, the Examiner characterizes *Lumsden* as constituting prior art under 35 U.S.C. § 102(e). This is incorrect. At best, *Lumsden* is available as prior art under 35 U.S.C. § 102(a). Because *Lumsden* is only citable

Application No. 09/649,436
Amendment dated September 7, 2004
Reply to Office Action mailed March 5, 2004

of *Lumsden* is modified only in that each of the search keywords are highlighted. While the entire document content is made available to the user, the user can selectively display and navigate to those portions of the document content incorporating the highlighted keyword. The Examiner states that since the user is only viewing portions of the search result at a given time (i.e., those portions that have highlighted keyword), that these "reduced content" portions constitute a "distilled" version of the search result. Applicants agree that under *Lumsden*, the only modification of the search result is that search keywords are highlighted and configured to allow selection by the user for navigation throughout the document. However, the fact remains that this modified search result – from a content standpoint – constitutes the entire version of the original search result, and this is what is returned to the user:

In Step 112, the search server 62 then prepares the document for review by the user before forwarding the document back to the client 60. Preferably, the preparation includes modifying the search criteria matches as they appear in the document so that the matches will be visually distinctive to the user when the user views the document. For example, if the user had used keywords "Orlando," "vacation" and "home" in the search request form, the search server 62 would visually alter these terms in the document relative to the rest of the document so that the user would be able to easily find these words within the document. (Column 6, lines 56-67; emphasis added).

Thus, the content of the entire search result document is forwarded to the user – it has been enhanced only in the manner described above, i.e., there is absolutely no reduction of content that takes place (in fact, the document is "enhanced" as described by *Lumsden*). When the document is displayed by the user, the portion of the document containing the first occurrence of the highlighted keyword is displayed, i.e., via a browser window. As construed by the Examiner, since this browser window contains a portion of the text of the search result document (a so-called "reduced content" version), then this corresponds to the claimed "distilled version." See Office Action, page 13, first paragraph. As an initial matter, this is not technically correct. For example, if the document content is small to begin with; is displayed with a small/reduced font; is displayed on a large display terminal; etc., then the entire document may be displayed to the user, having each of the keywords highlighted. Moreover, as is well known,

under 35 U.S.C. § 102(a) Applicants do not admit that *Lumsden* is in fact prior art to the claimed invention but

Application No. 09/649,436
Amendment dated September 7, 2004
Reply to Office Action mailed March 5, 2004

the browser itself logically "contains" the entire document; it can only display portions at a given time however, based on, for example, the above types of constraints.²

In any event, display of only portions of the entire document at a given time is not what is required by the pending claims. While it is believed that this concept was previously set forth in the claims, amendments have been made to further clarify the concept of "distillation" and the creation of a "distilled version." For example, claim 1 specifies that a search result, located for example by way of a keyword search, have a "first content." This would be, for example, a text document located via a search – wherein the entire textual content of the document constitutes the "first content." The claim further specifies a "distilling step," wherein content is "extracted" from the first content of the selected search result in "accordance with at least one data type criterion." Again, a data type criterion can be selected by a user (or can be a default value(s)) and functions as a data extraction rule. The extracted content is then used to create at least a portion of the distilled version of the selected search result. Moreover, the distilled version "constitutes a data entity having a preddefined format and that is distinct from the selected search result." For example, as is taught in the specification, the distilled version can be a data entity in the form of a data object, such as an XML object that is defined with tags that contain content extracted from the search result in accordance with specified data types. See, page 19, lines 4-13. Of course, data entities having different formats and content structures can be used.

This creation of a distilled version – a data entity that is separate and distinct from the search result – is a concept that is entirely different than what is taught or suggested by *Lumsden*. As conceded by the Examiner and discussed above, *Lumsden* merely teaches that a search result be "enhanced" by highlighting the keywords contained therein, and that the full content version of the search result be returned for viewing by the user. This full content version can then be easily navigated by the user, by displaying portions of the document (search result) in the user's browser window – and only those portions that include the highlighted keywords are displayed at a given time. Thus, the user is able to review a search result in context – i.e., by successively

reserve the right to swear behind *Lumsden* if necessary to remove it as a reference.

² The Examiner, at the bottom of page 13 of the Office Action, also cites language from Applicant's specification, which describes the function of highlighting search terms within a document, similar to that described by *Lumsden*. Of course, this comparison is completely irrelevant. The section cited by the Examiner relates to the concept of "key points" and has nothing to do with the claim terms and concepts at issue, namely the distillation of a search result. Whether *Lumsden* is anticipatory of the present invention depends on whether it teaches each and every element of a claim, not whether it teaches concepts discussed in Applicants' specification.

Application No. 09/649,436
Amendment dated September 7, 2004
Reply to Office Action mailed March 5, 2004

scrolling/displaying through the entire content by skipping to locations that include the keyword. Nowhere does *Lumsden* teach (1) that content be extracted from the search result, or (2) that a separate data entity - a distilled version - be created with extracted content, or (3) that content be extracted in accordance with a "data type criterion." Indeed, the concept of distilling the content of a search result into a separate data entity is entirely contrary to what is taught by *Lumsden*; indeed, creation of separate data entities for each highlighted keyword would be nonsensical, and inconsistent with the stated objectives of *Lumsden*, to "provide users of a Web search product with search results in context." (Column 2, lines 37-38). In other words, while *Lumsden* provides an enhanced means for navigating a search result, the user is still able to navigate through the entire content of the search result in the traditional manner - i.e., by scrolling through the text of the document.

In addition to pending independent claim 1, these distinctions apply to each of the pending independent claims. For example, it is believed that independent claim 6 is distinct from the teachings of *Lumsden* for a number of reasons. First, the claim specifically requires that upon distillation of a selected source document, a result object is created. As demonstrated above, nowhere is this suggested by *Lumsden*. To further emphasize this distinction, the claim has been amended to further recite the fact that the "result object" has a predefined format, and is a "distinct data entity" from the selected source document. Further, the claim requires that an "index" be created from the result object to the selected source document. Selection of the index provides a display of content from the source document that corresponds to the selection. This is not taught by *Lumsden*. At best, *Lumsden* teaches that the highlighted search terms within a search result can be selected so as to display the next occurrence of the search term and associated content within the same search result. In other words, *Lumsden* teaches the creation of an index within an individual document. It does not teach the creation of an index from one data entity, for entry into the content of a separate entity, as is required by the claim. Thus, for at least this reason, claim 6 is patentably distinct from the teachings of *Lumsden*.

Likewise, independent claim 10 includes elements not shown or suggested by *Lumsden* or any other art of record. In particular, the claim requires the presence of a distilled result object, that is created as a separate data entity from the search result. As discussed, this is not shown by *Lumsden*. Moreover, the claim specifically requires the display of a "mid-menu."

Application No. 09/649,436
Amendment dated September 7, 2004
Reply to Office Action mailed March 5, 2004

Nowhere does *Lumsden* teach or suggest this concept. The language cited by the Examiner as allegedly teaching this notion (Column 6, lines 67 to Col. 7 line 22) pertains to the display of *Lumsden's* "enhanced document," which constitutes the document located via the search with search terms highlighted. There is no separate "mid-menu" displayed, as is required by the claim. Further, there is nothing resembling the notion of a "plurality of menu options" each of which include a "result category" and a "content metric." Again, the Examiner cites to Column 6, lines 67 to Col. 7 line 22 as allegedly teaching such elements. Also, the Examiner cites to Figure 5 in support of the rejection. This reliance is puzzling, in that Figure 5 merely denotes a display showing a listing of the search results: "A screen capture of a browser 70 having search results in the form of a hit list 72 displayed therein is illustrated in Fig. 5." Column 6, lines 15-17. This is merely a listing of the search results. It is not any sort of "mid-menu" that corresponds to a "result object," as is specifically recited by claim 10. Hence, it is believed that claim 10 (in both its original and amended form) include elements that are not disclosed by *Lumsden*. As such, the claim is not anticipated by that, or any other reference of record, and should be allowed. Further, for at least the same reasons set forth for claim 10, independent claim 19 is believed to also be patentably distinct.

With respect to independent claims 22 and 34, each of those claims include limitations similar to those discussed above. For at least the same reasons as discussed in connection with previous claims, these claims are also patentably distinct with respect to *Lumsden* and other art of record. As such, Applicants respectfully request that the rejection of those claims be withdrawn.

In sum, each of the rejected independent claims – claims 1, 6, 10, 19, 22 and 34 -- are believed to include elements that are not taught by the *Lumsden* reference. As such, the Examiner has failed to state a *prima facie* case of anticipation. As such, Applicants respectfully request that the rejection of these claims under 35 U.S.C. § 102(a) be withdrawn. Moreover, for at least the same reasons as stated in connection with the independent claims, each of the claims depending from these claims are also in a condition for allowance. Claims 1-2, 6, and 10-43 should all now be allowed.

Application No. 09/649,436
Amendment dated September 7, 2004
Reply to Office Action mailed March 5, 2004

2. Rubinstein et al.

The Examiner rejects claims 44-46 under 35 U.S.C. § 102(b) as being anticipated by *Rubinstein et al.* (United States Patent No. 5,913,215). Applicants respectfully traverse this rejection.

To summarize, the Examiner disagrees with Applicants' previous arguments with respect to the teachings of *Rubinstein*. In the Office Action, the Examiner states:

First, Applicant incorrectly assumed that in *Rubinstein*, "each of the documents in the database being searched has been **previously** linguistically analyzed to identify the keyword phrases contained within each document, and to create an abstract of each document in the database," and therefore incorrectly concluded that *Rubinstein* does not teach the step of generating the abstract "at substantially the time of selection of one of the search results." In fact, *Rubinstein* performs the "linguistically analyzing" in real time, **a fter** receiving user's query, and generated web page abstract based on the linguistic analysis of the selected web page **a fter** user selection of the web page.

(Office Action, page 14 (emphasis in original)).

In support, the Examiner then cites to language culled from independent claim 1 of the *Rubenstein* patent. The text of that claim is reproduced below for convenience:

1. A method for presenting to a computer-user information from web pages containing text consistent with a search expression, said method comprising the computer-implemented steps of:

- prompting a computer-user to construct a search expression;
- communicating the search expression to a plurality of web searching engines;
- prompting each of the plurality of web searching engines to concurrently inspect a respective plurality of web pages and to identify web pages containing text consistent with the search expression;
- linguistically analyzing the identified web pages to obtain keyword phrases therefrom; and
- displaying the keyword phrases obtained from the identified web pages in a navigable cross-index.

(Claim 1, emphasis added).

The Examiner's position is wrong in a number of respects. First, the Examiner asserts that the cited claim language supports the view that "linguistic analysis" occurs in real time, i.e.,

Application No. 09/649,436
Amendment dated September 7, 2004
Reply to Office Action mailed March 5, 2004

substantially at the time of selection of a search result (as is specifically required by claim 44). This is simply not true: there is absolutely nothing in the wording of the claim that indicates that the "linguistically analyzing" step occur in substantially "real time" or even at the time of selection of a search result. Indeed, the claim specifies no time relationship whatsoever as between the searching step and the linguistically analyzing step. Applicants respectfully request that the Examiner cite any language to this effect.

Further, any interpretation of the cited claim that would result in the linguistically analyzing step occurring in "real time" would be in direct contradiction to that which is taught in the specification. As has been discussed in previous responses, *Rubinstein* specifically teaches a methodology for assisting a user in locating and identifying a single document (or web page) from a plurality of documents (or web pages). The location of a document from a database of documents (the database to be searched is referred to by *Rubinstein* as an "archive catalog") is facilitated by "prompting a computer user to construct a query expression from an automatically generated list of keyword phrases." *Rubinstein* at col. 4, lines 19-23. Again, for a given plurality of documents that make up a archive catalog, *Rubinstein* specifically requires that the linguistic analysis first be completed for all of the documents so as to thereby create the list of keyword phrases and an abstract for all of the documents. The user can then use this list of keyword phrases to construct a Boolean search phrase and thereby locate a specific document contained within the archive catalog.

The embodiment pertaining to claim 1 (cited by the Examiner) pertains to the notion of creating a list of keyword phrases for a use in connection with a "plurality of web pages" that together make up an "archive catalog" database. The plurality of web pages are first located via "multiple web searching engines" that search on a "search expression," which results in the identification of "web pages containing text consistent with the search expression." (Claim 1, element 3, emphasis added). All of the identified web pages are then linguistically analyzed, so as to generate keyword phrases therefrom. (Claim 1, element 4, emphasis added):

each of the web pages in the initial set of web pages is linguistically analyzed to identify keyword phrases therein. In one embodiment of the present invention, this is accomplished by downloading and linguistically analyzing the contents of each web page concurrently with the ongoing search initiated in step 815. In step 825, the computer user is prompted to construct a query expression in which at least one of the keyword phrases is an operand, and in step 830, the query expression is used to identify one web page of the initial set of web pages.

Application No. 09/649,436
Amendment dated September 7, 2004
Reply to Office Action mailed March 5, 2004

... In one embodiment of the present invention, the abstract has been previously generated based on linguistic analysis of the web page.

Column 16, lines 7-13, lines 40-41 (emphasis added). The keywords are then presented to a user as "navigable cross-index" (using the language of claim 1, element 5), which can then be used to construct a search query so as to allow the user to locate a specific web page document contained within the archive.

As is made clear throughout the specification, the linguistic analysis step is performed on a plurality of web pages. At no time is a search result "selected" and, at the time of selection "distilled" (or linguistically analyzed) as is specifically required by claim 44. In direct contrast, *Rubinstein* teaches that if, by use of the keyword phrases, the user does locate a single specific search result, "[a] previously generated abstract corresponding to the selected web page is then displayed." Column 16, lines 47-49 (emphasis added).

Thus, the Examiner's assertion that the language of *Rubinstein's* claim 1 teaches "real time" distillation (i.e., occurring substantially at the time of selection of a search result) is not supported by the claim language itself, and is inconsistent with the express teachings of the patent.

As a final matter, Applicants' respectfully note that the Examiner's reliance on a claim as a source of disclosure is, using the words of the Federal Circuit, constitutes a "plainly indefensible line of reasoning." *In re Benno*, 768 F.2d 1340, 1345 (Fed. Cir. 1985). In that case, the United States Patent and Trademark Office Board of Appeals (the "Board"), as is the Examiner in the present case, looked to a prior art reference claim as a source of disclosure in invalidating the patent application at issue. In rejecting that approach, the Federal Circuit emphasized that "[t]he scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses." *Id.* at 1346 (emphasis added). The court continued by noting that "[a] patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding." *Id.*

Here, *Rubinstein* clearly teaches a methodology whereby linguistic analysis is performed on a plurality of documents/web pages that make up a database. Irrespective of how broadly *Rubinstein's* claim 1 might be interpreted, nowhere does *Rubinstein* teach or suggest that a search result can be selected, and that substantially at the time of selection be distilled in accordance with data type rules. To reiterate, independent claim 44 specifically requires that a

Application No. 09/649,436
Amendment dated September 7, 2004
Reply to Office Action mailed March 5, 2004

"plurality of search results" be provided, and that "at substantially the time of selection" of one of the search results, the selected document be distilled. This is clearly not the case with *Rubenstein*, which provides no such "distillation" function upon selection of a search result. Indeed, this is totally contrary to the operation of *Rubinstein*, which requires that any "linguistic analysis" of the database of documents already have been performed; said differently, no type of distillation process occurs "at substantially the time of selection" as is required by the claim.

Since *Rubinstein* fails to teach or suggest a number of elements as arranged in pending claim 44, it is respectfully submitted that claim 44 is not anticipated by the *Rubinstein* reference. As such, withdrawal of the rejection of that claims is respectfully requested. Moreover, for at least the same reasons, each of the claims depending from claim 44 (claims 45-46) are also patentably distinct, and withdrawal of the rejection of those claims is also respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 7th day of September, 2004.

Respectfully submitted,



ERIC L. MASCHOFF
Registration No. 36,596
Attorney for Applicant
Customer No. 022913

C:\Documents and Settings\emaschof\My Documents\Surfwax\second response for 15777.1.2.2.doc